

REMARKS

Status of the claims:

With the above amendment, claim 1 has been amended. No new matter has been added by way of the above amendment. The amendment to claim 1 is non-narrowing in scope. Claims 1-9 are pending and ready for further action on the merits. Reconsideration is respectfully requested in light of the following remarks.

Claim Objections under 37 CFR §1.75(c)

Claim 3 has been objected to under 37 CFR §1.75(c) for an alleged failure to further limit claim 1. Applicants traverse.

Claim Differentiation

The Examiner asserts that the phrase "the molten rubber is melt-kneaded with the thermoplastic resin in the extruder" in claim 1 can only be interpreted so that the molten rubber is added after the thermoplastic resin is added. In other words, the Examiner interprets this phrase to mean that the thermoplastic resin is already in the extruder when the molten rubber is added. Applicants, however, assert that the resin may be present in the extruder before the introduction of the rubber or the resin may be introduced after the introduction of the rubber. Applicants believe that this difference in

interpretation results from what the prepositional phrase "in the extruder" modifies. In particular, the prepositional phrase "in the extruder" can modify "the thermoplastic resin" (the Examiner's interpretation) or the prepositional phrase "in the extruder" can modify "the molten rubber is melt-kneaded with the thermoplastic resin" (Applicant's interpretation). Thus, it is believed that one of skill in the art could interpret this phrase to mean either of these two interpretations. To make the interpretation unambiguous, Applicants have amended claim 1 so that the position of the prepositional phrase "in the extruder" is moved so that it unambiguously modifies the phrase "the molten rubber is melt-kneaded with the thermoplastic resin". It is believed that this change obviates the objection. Withdrawal of the objection is warranted and respectfully requested.

Rejections under 35 USC §§102/103

Claims 1-5 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Guntherberg '399. The Examiner asserts that lines 7-8 of the abstract disclose feeding the molten rubber into an extruder. Applicants are unable to find any such disclosure in Guntherberg '399 and invite the Examiner to point out specifically where this occurs. Applicants assert that Guntherberg '399 discloses adding components (A) to (D) to the extruder, with none of these components being molten rubber.

Accordingly, Guntherberg '399 cannot anticipate the instant invention because it fails to disclose the elements of the instantly claimed invention (i.e., molten rubber is present in claim 1). Withdrawal of the rejection is warranted and respectfully requested.

Moreover, regarding the obviousness rejection, the Examiner asserts that Furuta '756 does not disclose molten rubber being fed into the extruder, but further asserts that Furuta '756 is not being used for that purpose. Applicants agree that Furuta '756 does not disclose molten rubber. Accordingly, Applicants assert that the Examiner has failed to make out a *prima facie* case of obviousness with regard to any 35 USC §103(a) rejections over Guntherberg '399 with or without Furuta '756. Three criteria must be met to make out a *prima facie* case of obviousness.

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
- 2) There must be a reasonable expectation of success.
- 3) The prior art reference (or references when combined) must teach or suggest all the claim limitations.

See MPEP §2142 and *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991).

In particular, the Examiner has failed to meet the third element

to make a *prima facie* obviousness rejection. Neither Guntherberg '399 nor Furuta '756 disclose molten rubber. Accordingly, the rejection is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

With the above remarks and amendments, it is believed that the claims, as they now stand, define patentable subject matter such that a passage of the instant invention to allowance is warranted. A Notice to that effect is earnestly solicited.

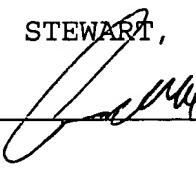
Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee of \$110.00 is attached hereto.

If any questions remain regarding the above matters, please contact Applicant's representative, T. Benjamin Schroeder (Reg. No. 50,990), in the Washington metropolitan area at the phone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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By 

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claims have been amended as follows:

1. (Three times Amended) A method of producing a composition comprising a thermoplastic resin and a rubber, wherein a solid rubber is turned into a molten rubber by a rubber kneading machine and the molten rubber is fed into an extruder from the rubber kneading machine, and in the extruder the molten rubber is melt-kneaded with the thermoplastic resin [in the extruder].